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OFFICE OF PETITIONS

In re Application of	:	
Massie, et al.	:	
Application No. 10/656,372	:	ON PETITION
Filed: September 8, 2003	:	
Attorney Docket No. 10890-1C	:	

This is a decision on the "Request for Reconsideration of Petition for Granting of a Filing Date under 37 CFR 1.53 and 1.182," filed September 14, 2005, requesting that the above-identified application be accorded a filing date of September 8, 2003, including the specification.

The application was submitted on September 8, 2003. However, on December 15, 2003, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Incomplete Nonprovisional Application," (Notice) that stated the application had not been accorded a filing date, and that the specification appears to have been omitted.

In response, on February 4, 2004, a copy of the specification was submitted. On April 20, 2004, the original petition was filed.

Petitioner stated in the original petition, "The circumstances involved are that when the above application was filed in the USPTO on September 8, 2003, the papers submitted inadvertently omitted a copy of the parent application 09/843,949 filed 04/30/2001 now US Patent No. 6,642,052 issued November 4, 2003. The papers did include however a copy of the original Declaration; a copy of the original Assignment document; a Preliminary Amendment to insert the parent application information into the original specification; the filing fee; and the Utility Patent Application Transmittal, indicating in Box 18 that this application is a Divisional of prior application 09/843,949..."

Petitioner requests the use of the incorporation by reference statement in Box 18 of the Utility Patent Application Transmittal to incorporate-by-reference the specification of prior application no. 09/843,949 in order to accord the above-identified application a filing date of September 8, 2003.

MPEP 201:06(c) states:

“A. Application NOT Entitled to a Filing Date

Material needed to accord an application a filing date may not be incorporated by reference. Therefore, if a continuation or divisional application as originally filed incorporates by reference material omitted from the application papers, which is needed to accord the application a filing date, the application will not be entitled to a filing date. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.”

Petitioner has submitted the required petition, petition fee, and an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement.

The petition is granted.

Based on petitioners' representation that the specification supplied with the petition is a part of the disclosure of prior application no. 09/843,949 and that the entire disclosure of prior application no. 09/843,949 was specifically incorporated by reference in the present application on September 8, 2003, it appears that the specification was present in the Office on September 8, 2003, albeit in the file of another application, i.e., application no. 09/843,949. Therefore, on petition, the application may be granted the requested filing date of September 8, 2003.

Of course, the primary examiner is expected to compare the specification supplied on September 14, 2005, to the disclosure of prior application no. 09/843,949 in order to verify that the specification is, in fact, part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination for processing with a filing date of September 8, 2003, and issuance of a corrected filing receipt, using the specification supplied on September 14, 2005.

Telephone inquiries should be directed to the undersigned at (571) 272-3228.

A handwritten signature in black ink, appearing to read 'E. Tannouse', followed by a long horizontal line.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy